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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,689	03/29/2004	Mitsuhiro Naito	118407	1104
25944	7590	01/31/2007	EXAMINER	
OLIFF & BERRIDGE, PLC			MANCHO, RONNIE M	
P.O. BOX 19928				
ALEXANDRIA, VA 22320			ART UNIT	PAPER NUMBER
			3663	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/31/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/810,689	NAITO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ronnie Mancho	3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 October 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 7-11,13,14,16,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 7-11,13,14, 16, 19, and 21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 7-15, 21, and species B and C in the reply filed on 10/26/06 is acknowledged. The traversal is on the ground(s) that claims 16 is a linking claim to claims 1 and 9 and that the claims are generic. Claims 16 and 19 will be linked with elected claims 7-15, 21.
2. The applicant further argues that the restriction is improper because the claims as disclosed are intended to be used for search, rescue, and entertainment similar to the search, rescue, and entertainment cited in the restriction. It is noted that although the invention is used for route search, facility search, parking lot search, as disclosed by the applicant, what the examiner meant by search and rescue in the restriction was the search and rescue of stolen vehicles or for vehicle theft prevention. The entertainment referred to by the examiner was directed to tracking the position of a race car on a racing track and using the tracking data for the race car entertaining industry. Thus the apparatus as claimed can be used to practice another and materially different process.

The applicant further argues that the election of species requirement is improper. The examiner disagrees. Applicant admits and discloses patentably distinct species in the specification. Applicant does not argue that the species or the groups are not patentably distinct.

Therefore, the requirement is still deemed proper and is therefore made FINAL.

3. Applicant's election of species B and C further withdraws claims 12 and 15. Therefore, claims 7-11, 13, 14, 16, 19, and 21 are pending.

Art Unit: 3663

4. Claims 1-4, 6, 12, 15, 17, 18, 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected non elected invention, there being no allowable generic or linking claim.

5. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/26/06.

***Claim Objections***

6. Claim 7 is objected to because of the following informalities:

In amended claims 7 and 21, the applicant recites, “a navigation device, for installation in a vehicle, comprising:

a communication portion that is configured to communicate with a server that distributes data, a network driver being necessary for communication between the communication portion and the server”.

Applicant is advised to use the appropriate semicolon. That is applicant is advised to write the phrase, “that distributes data, a network driver” as -- that distributes data; a network driver-- for clarity since applicant’s navigation device comprises: a communication portion; a network driver; and a data storage (semicolon emphasized). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3663

8. Claims 7-11, 13, 14, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 7-11, 13, 14, 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

In claim 7, the applicant omitted a controller essential for start up of the navigation device, other devices, and a network driver. Instead, the controller essential for start up was mentioned in dependent claim 8.

The rest of the claims are rejected for depending on a rejected base claim.

10. Claims 7-11, 13, 14, 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

In amended claims 7 and 21, the applicant recites, “a communication portion that is configured to communicate with a server that distributes data, a network driver being necessary for communication between the communication portion and the server”. That is, the applicant recites that the network driver is necessary for communication, but does not claim that the network driver has been connected with the other units in the invention to carry out communication. That is claim 8 recites steps that are method limitations in an apparatus claim. The steps refer to a controller that initiates a start up of the navigation device and the network driver. Thus in order to operate, the start up system needs to be present in the independent claim.

Therefore, the applicant has omitted essential structural cooperative relationships of elements in the claim.

The rest of the claims are rejected for depending on a rejected base claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 7-11, 13, 14, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawamoto (US 6314295).

Regarding claim 7, Kawamoto (abstract; figs. 1-4, 9, 13-15; col. 6, lines 25-40; col. 12, lines 7-40; cols. 5, 8, 9) disclose a navigation device 81 (col. 6, lines 63 to col. 7, lines 67), for installation in a vehicle (col. 12, lines 4-40), comprising:

a communication portion 98 (fig. 2) that is configured to communicate with a server 86 that distributes data (abstract; figs. 1-4, 9; col. 6, lines 63 to col. 7, lines 67; cols. 5, 8, 9);  
a network driver 94 (figs. 2, 14; col. 5, lines 56-65, col. 6, lines 63 to col. 7, lines 67; col. 12, lines 7-40) being necessary for communication between the communication portion and the server 86; and

a data storage portion (RAM, col. 6, lines 30-59) that stores the data that is distributed from the server, wherein:

Art Unit: 3663

when an accessory signal causing the navigation device to be supplied with electric power is received from the vehicle, the network driver 94 starts up (col. 6, lines 26-39);

prior to initiating start-up of other device drivers (RAM 93, display 95, etc; figs. 1-4, 9, 13-15), the network driver 94 communicates with the server to receive the distributes data (col. 6, lines 26-40; col. 12, lines 7-40); and

starting-up, after the distribution data is received from the server, the other device drivers (RAM 93, display 95, etc; figs. 1-4, 9, 13-15. That is the RAM is instructed to start up storing ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received).

Regarding claim 8, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, further comprising a controller 91 that:

initiates start up of the navigation device 81 (col. 5, lines 61-65, col. 6, lines 3-40); starts-up the network driver 94 (col. 5, lines 61-65, col. 6, lines 3-7) ; instructs the network driver 94 to communicate with the server 86 (that is data from the CPU is communicated to the network driver 94 and then through the communication portion to the server), prior to the start-up of the other drivers (RAM 93, display driver 95, etc; col. 6, lines 26-40; col. 12, lines 7-40; cols. 5, 8, 9).

Regarding claim 9, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, further comprising: at least one of a display portion and a voice output portion, wherein after start-up of the navigation device is completed, data

Art Unit: 3663

stored in the data storage portion is at least one of displayed on the display portion and voice output from the voice output portion.

Regarding claim 10, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9, 12) disclose the navigation device of claim 7, wherein when an operating system starts up following initiation of a start-up of the navigation device:

the network driver starts up and the distributed data is downloaded, and  
after the distributed data is downloaded, start-up of the other device drivers and an application program is executed.

Regarding claim 11, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein data that is pre-set is downloaded from the server.

Regarding claim 13, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion is a removable cellular terminal.

Regarding claim 14, Kawamoto (abstract; figs. 1-4, 9; col. 6, lines 25-40; cols. 5, 8, 9) disclose the navigation device of claim 7, wherein the communication portion communicates directly with the server.

Regarding claim 21, Kawamoto (abstract; figs. 1-4, 9, 13-15; col. 6, lines 25-40; col. 12, lines 7-40; cols. 5, 8, 9) disclose a navigation device, for installation in a vehicle (col. 12, lines 7-40), comprising:

a communication portion 98 that is configured to communicate with a server 86 that distributes data (abstract; figs. 1-4, 9; col. 6, lines 26-40; cols. 5, 8, 9);

a network driver 94 (figs. 2, 14; col. 5, lines 61-65, col. 6, lines 3-7; col. 12, lines 7-40)

being necessary for communication between the communication portion and the server 86;

a data storage portion (RAM, col. 6, lines 30-59) that stores the data that is distributed from the server; and

a navigation processing portion 91 that:

starts up the network driver 94 when an accessory signal causing the navigation device to be supplied with electric power is received from the vehicle (col. 5, lines 57 to col. 6, lines 40);

causes the network driver 94 to communicate with the server to receive the distributes data (col. 6, lines 26-40; col. 12, lines 7-40; col. 12, lines 7-40) prior to initiating start-up of other device drivers (RAM 93, display 95, etc; figs. 1-4, 9, 13-15), wherein the network driver 94 communicates with the server to receive the distributed data; and

starts-up, after the distribution data is received from the server, the other device drivers (RAM 93, display 95, etc; figs. 1-4, 9, 13-15. That is the RAM is instructed to start up storing ID of a base station, the display driver 95 is instructed to start up displaying the map AFTER distribution data from the server and network have been received).

13. Regarding claim 7, Ito Yasuo (JP 2001-148092) disclose a navigation device 100 (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) for installation in a vehicle, comprising:

a communication portion 108 (fig. 2) that is configured to communicate with a server 10 that distributes data (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant);

a network driver 102 (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) being necessary for communication between the communication portion and the server 10; and

a data storage portion 102B (abstract; figs. 1, 2; sections 0032-0035 of the translation submitted by applicant) that stores the data that is distributed from the server.

Since the prior art anticipates the structure of the invention, the structure of the prior art is capable of performing the following limitations:

wherein:

when an accessory signal causing the navigation device to be supplied with electric power is received from the vehicle, the network driver starts up;

prior to initiating start-up of other device drivers, the network driver communicates with the server to receive the distributes data; and

starting-up, after the distribution data is received from the server, the other device drivers.

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Odashima et al (6650970).

Regarding claim 16, Odashima et al (abstract, cols. 3-5; figs. 1, 6-11) disclose a navigation device 40, for installation in a vehicle (col. 3, lines 16-46; col. 4, lines 43 to col. 5, lines 65), comprising:

means for receiving an accessory signal from the vehicle causing the navigation device to be supplied with electric power (fig. 6; col. 4, lines 43 to col. 5, lines 65);

means 400 for starting up, once the navigation device 40 is supplied with power, a network driver 42 of the navigation device (fig. 6; col. 4, lines 43 to col. 5, lines 65);

means 46 for instructing, prior to initiating start-up of other device drivers (43, 44, 45, fig. 6), the network driver 42 (fig. 6; col. 4, lines 43 to col. 5, lines 65) to communicate with a server 2 (fig. 1);

means 47 for receiving data from the server 2 using the network driver (fig. 6; col. 4, lines 43 to col. 5, lines 65);

means for starting up, after the data is received from the server, the other device drivers (43, 44, 45, fig. 6).

Art Unit: 3663

Regarding claim 19, Odashima et al (abstract, cols. 3-5; figs. 1, 6-11) disclose the navigation device of claim 16 , wherein the communication is via wireless communication device 47 or a removable wireless communication device.

16. With regard to claims 7-11, 13, 14, 21, the statements of intended use or field of use, “for installation”, “necessary for communication between”, “wherein when....to be supplied with electric power is received from, .....starts up”, “prior to initiating”, “start-up after.....data is received”, “accessory signal causing”, etc clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

***Response to Arguments***

17. Applicant's arguments filed 4/14/06 and 10/26/06 have been fully considered but they are not all persuasive.

Applicant has amended and elected a certain group of claims and canceled the un elected claims. The arguments drawn to non-elected claims are moot.

The applicant argues the 102 (e) rejection is improper because the examiner did not give patentable weight to the intended use limitations in the apparatus claims. The applicant further pointed out that the reliance on MPEP 2114 was improper and as such the 102 rejection is improper.

Applicant's arguments are respectfully traversed. It is noted that the applicant is claiming an apparatus that is not yet constructed in a manner so as to perform the functions it is supposedly capable of performing. Applicant's arguments traversing the cited MPEP section MPEP 2114 is misplaced because applicant admits that MPEP 2114 is valid for cases where the prior art structure anticipates the structure of the invention. As noted in applicant's arguments, the prior art structure anticipates the structure of the invention. Note! Applicant is not claiming a process, the applicant is claiming an apparatus. Therefore, the rejection is proper.

Applicant's citation of the court cases to support the arguments is misplaced because the cited court cases do not apply to the present situation in the invention. As an example one of the court cases appears to be indicating that functional clauses that define structural limitations cannot be disregarded. In applicant's invention, the cited functional in the rejection clauses describe the intended use of the invention and have no bearing or in any way define the structure

of the invention. As a matter of fact, the intended use limitations were not ignored as urged by the applicant, they were all addressed in the rejection.

Applicant can overcome the MPEP 2114 citation by writing the claims in a proper means plus function format or by providing structure limitations that define over the prior art. It is believed that the rejection is proper and therefore stands.

*Communication*

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571-272-6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronnie Mancho  
Examiner  
Art Unit 3663

1/18/07

JACK KEITH  
SUPERVISORY PATENT EXAMINER